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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,520

10/07/2005

Vincent Granier

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2571

7590

06/09/2008

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,520	Applicant(s) GRANIER ET AL.	
	Examiner Patrick D. Niland	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008 and 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/08 has been entered.

The amendment of 2/11/08 and 5/12/08 has been entered. Claims 10-21 are pending.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what the units of the value of claim 11 are to be since they are not specified.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/31960 Navavi et al. as translated by US Pat. Application Pub. No. US 2003/0158328 Nabavi et al..

Nabavi discloses compositions, which adhere to substrates and are therefore “adhesive”, made by adding the instantly claimed component b to polyisocyanates falling within the scope of those

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of the instant claims at the abstract; sections [0010], [0022], [0026], [0029]-[0059], particularly [0050]-[0059] which encompasses the instantly claimed component b, [0068] which falls within the scope of the instant claim 12, [0108]-[0127], particularly [0109]-[0111], which falls within the scope of the instant claims 11, 14, 15, and 17; and the remainder of the document, particularly the examples of sections [0167]-[0228]. It would appear that the polyisocyanates of the examples have the limitations of the instant claims 14-17 inherently. The newly presented claim limitations of claims 19-21 are encompassed by these sections also. The applicant's arguments regarding Nabavi's silence on the application of their compositions to bond wood or elastomer, these limitations are not required of the examined claims which are methods of making the composition and the composition. Regarding the prior art not disclosing "the fact that the composition must present the following features to be used as a bonding composition...", the instant claims are directed to compositions and the methods of making them. The prior art encompasses the claimed NCO content and viscosities as addressed above. The intended use does not distinguish over the prior art methods and compositions disclosed because the prior art uses the instantly claimed method steps and ingredients and amounts thereof. It is also not seen that the compositions of the prior art cannot bond wood or elastomer. The processes and compositions of the prior art therefore fall within the scope of the instantly claimed compositions and processes of making since they otherwise are composed of the instantly claimed steps and ingredients. "Adhesive" references a future intended use which does not distinguish the instant claims over the methods and compositions of the cited prior art for the reasons given above. As stated above and as is readily clear, paints and varnishes adhere to substrates and are therefore "adhesive". The applicant's arguments in this regard are not

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persuasive. Furthermore, the composition of the cited prior art and method of making it are not distinguished from the instant claims by the instantly claimed recitations of "adhesive" or similar language because the compositions and methods of the cited prior art have the instantly claimed ingredients and employ the instantly claimed method steps. The resulting product will therefore necessarily and inherently be able to adhere some substrate to another, were "adhesive" defined to require this in the instant claims. The examiner maintains that this is not the case in any event and the adhesion of the paints and varnishes meets the instantly claimed recitation of "adhesive". The applicant's arguments have been fully considered, including those of 2/11/08, but are not persuasive for the above reasons. This rejection is therefore maintained.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Patrick D Niland/
Primary Examiner
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